

## **REMARKS**

Applicants respectfully request entry of the following amendments and remarks in response to the Office Action mailed October 28, 2008. Applicants respectfully submit that the amendments and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1 – 20 are pending. In particular, Applicants add claim 20 and amend claims 13 – 19. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **I. Rejections Under 35 U.S.C. §101**

The Office Action indicates that claims 13 – 19 stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Applicants amend claims 13 – 19, as indicated above. Applicants submits that these amendments comply with the Office Action request and that claims 13 – 19, as amended, fulfill all the requirements of 35 U.S.C. §101.

### **II. Rejections Under 35 U.S.C. §103**

#### **A. Claim 1 is Allowable Over Hickey**

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2002/0087646 (“*Hickey*”). Applicants respectfully traverse this rejection for at least the reason that *Hickey* fails to disclose, teach, or suggest all of the elements of claim 1. More specifically, claim 1 recites:

A communication system comprising:  
a client-side group email folder accessible by each user in a predefined group of users; and  
a group email message in the client-side group email folder, the group email message having *indicators, each indicator corresponding to a user in the predefined group of users, each indicator being configured to indicate whether the corresponding user has acted upon the group email message,*

wherein the group email message is stored in a common database such that the users in the predefined group of users have access to the group email message via the database,

wherein the communication system is configured to provide an email interface for providing the group email message and an option to view at least one user-specific email, the user-specific email being different than the group email message.

**(Emphasis added).**

Applicants respectfully submit that claim 1 is allowable over the cited art for at least the reason that *Hickey* fails to disclose, teach, or suggest a "communication system comprising... a group email message in the client-side group email folder, the group email message having ***indicators, each indicator corresponding to a user in the predefined group of users, each indicator being configured to indicate whether the corresponding user has acted upon the group email message***" as recited in claim 1. The Office Action argues "*Hickey* discloses a group electronic mailbox with a status indicator for each group email message received by a member in the group... *Hickey* further teaches a status indicator for the group electronic mailbox in which the indicator is updated when a member of the group causes a change in status" (OA page 2, line 100). Applicants respectfully disagree. More specifically, as illustrated, FIG. 6 of *Hickey* depicts an email inbox. Accordingly, the status column 143B indicates a status of the email messages in the inbox. However, there is only one indicator for each email. Consequently, *Hickey* cannot disclose "the group email message having ***indicators, each indicator corresponding to a user in the predefined group of users, each indicator being configured to indicate whether the corresponding user has acted upon the group email message***" as recited in claim 1 because each email message in *Hickey* only includes one indicator. To further illustrate this point, *Hickey* uses the singular form of the word "indicator" to indicate there is only one indicator for each email message "[a] second column 143B includes status indicator" (emphasis added, page 7, paragraph [0063]). For at least these reasons, claim 1 is allowable.

**B. Claim 10 is Allowable Over Hickey**

The Office Action indicates that claim 10 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2002/0087646 ("*Hickey*"). Applicants respectfully traverse this rejection for at least the reason that *Hickey* fails to disclose, teach, or suggest all of the elements of claim 10. More specifically, claim 10 recites:

A communication method comprising:  
providing ***indicators in a group email message, the group email message being provided to a predefined group of users, each indicator corresponding to one of the users in the predefined group of users, each indicator having a setting, each indicator configured to indicate whether the corresponding user has acted upon the group email message;***  
changing the setting of one indicator in response to the email message being acted upon by its corresponding user; and  
providing an email interface for providing the group email message and an option to view at least one user-specific email, the user-specific email being different than the group email message,  
wherein the group email message is stored in a common database such that the users in the predefined group of users have access to the group email message via the database.

***(Emphasis added).***

Applicants respectfully submit that claim 10 is allowable over the cited art for at least the reason that *Hickey* fails to disclose, teach, or suggest a "communication method comprising... providing ***indicators in a group email message, the group email message being provided to a predefined group of users, each indicator corresponding to one of the users in the predefined group of users, each indicator having a setting, each indicator configured to indicate whether the corresponding user has acted upon the group email message***" as recited in claim 10. The Office Action argues "*Hickey* discloses a group electronic mailbox with a status indicator for each group email message received by a member in the group... *Hickey* further teaches a status indicator for the group electronic mailbox in which the indicator is updated when a member of the group causes a change in status" (OA page 2, line 100). Applicants respectfully disagree. More specifically, as illustrated, FIG. 6 of *Hickey* depicts an

email inbox. Accordingly, the status column 143B indicates a status of the email messages in the inbox. However, there is only one indicator for each email. Consequently, *Hickey* cannot disclose "providing *indicators in a group email message, the group email message being provided to a predefined group of users, each indicator corresponding to one of the users in the predefined group of users, each indicator having a setting, each indicator configured to indicate whether the corresponding user has acted upon the group email message*" as recited in claim 10 because each email message in *Hickey* only includes one indicator. To further illustrate this point, *Hickey* uses the singular form of the word "indicator" to indicate there is only one indicator for each email message "[a] second column 143B includes status indicator" (emphasis added, page 7, paragraph [0063]). For at least these reasons, claim 10 is allowable.

**C. Claim 13 is Allowable Over *Hickey***

The Office Action indicates that claim 13 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2002/0087646 ("*Hickey*"). Applicants respectfully traverse this rejection for at least the reason that *Hickey* fails to disclose, teach, or suggest all of the elements of claim 13. More specifically, claim 13 recites:

A tangible computer readable medium that includes a computer program that, when executed by a computer, performs at least the following:

providing *indicators in a group email message, the group email message being provided to a predefined group of users, each indicator corresponding to one of the users in the predefined group of users, each indicator having a setting, each indicator configured to indicate whether the corresponding user has acted upon the group email message*;

changing the setting of one indicator in response to the email message being acted upon by its corresponding user; and

providing an email interface for providing the group email message and an option to view at least one user-specific email, the user-specific email being different than the group email message,

wherein the group email message is stored in a common

database such that the users in the predefined group of users have access to the group email message via the database.  
**(Emphasis added).**

Applicants respectfully submit that claim 13 is allowable over the cited art for at least the reason that *Hickey* fails to disclose, teach, or suggest a “tangible computer readable medium that includes a computer program that, when executed by a computer, performs at least the following... providing ***indicators in a group email message, the group email message being provided to a predefined group of users, each indicator corresponding to one of the users in the predefined group of users, each indicator having a setting, each indicator configured to indicate whether the corresponding user has acted upon the group email message***” as recited in claim 13. The Office Action argues “Hickey discloses a group electronic mailbox with a status indicator for each group email message received by a member in the group... Hickey further teaches a status indicator for the group electronic mailbox in which the indicator is updated when a member of the group causes a change in status” (OA page 2, line 100). Applicants respectfully disagree. More specifically, as illustrated, FIG. 6 of *Hickey* depicts an email inbox. Accordingly, the status column 143B indicates a status of the email messages in the inbox. However, there is only one indicator for each email. Consequently, *Hickey* cannot disclose “providing ***indicators in a group email message, the group email message being provided to a predefined group of users, each indicator corresponding to one of the users in the predefined group of users, each indicator having a setting, each indicator configured to indicate whether the corresponding user has acted upon the group email message***” as recited in claim 13 because each email message in *Hickey* only includes one indicator. To further illustrate this point, *Hickey* uses the singular form of the word “indicator” to indicate there is only one indicator for each email message “[a] second column 143B includes status indicator” (emphasis added, page 7, paragraph [0063]). For at least these reasons, claim 13 is allowable.

**D. Claims 2 – 7, 9, 11 – 12, and 14 – 18 are Allowable Over *Hickey***

The Office Action indicates that claims 2 – 7, 9, 11 – 12, and 14 – 18 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2002/0087646 (“*Hickey*”). Applicants respectfully traverse this rejection for at least the reason that *Hickey* fails to disclose, teach, or suggest all of the elements of claims 2 – 7, 9, 11 – 12, and 14 – 18. More specifically, dependent claims 2 – 7 and 9 are believed to be allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 1. Dependent claims 11 – 12 are believed to be allowable for at least the reason that they depend from and include the elements of allowable independent claim 10. Further, dependent claims 14 – 18 are believed to be allowable for at least the reason that they depend from and include the elements of allowable independent claim 13. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

**E. Claims 8 and 19 are Allowable Over *Hickey* in view of *Stark***

The Office Action indicates that claims 8 and 19 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2002/0087646 (“*Hickey*”) in view of U.S. Patent Publication Number 2003/0233420 (“*Stark*”). Applicants respectfully traverse this rejection for at least the reason that *Hickey* in view of *Stark* fails to disclose, teach, or suggest all of the elements of claims 8 and 19. More specifically, dependent claims 8 and 19 are believed to be allowable over *Hickey* for at least the reason that these claims depend from and include the elements of allowable independent claim 1. Because *Stark* fails to overcome the deficiencies of *Hickey*, claims 8 and 19 are allowable as a matter of law. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

### **CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, all objections and/or rejections have been traversed, rendered moot, and/or addressed, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/afb/

**Anthony F. Bonner Jr. Reg. No. 55,012**

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
Suite 1500  
600 Galleria Parkway SE  
Atlanta, Georgia 30339  
(770) 933-9500  
Customer No.: **38823**